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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,705

01/08/2004

Muhammad A. Ahmed

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11/17/2006

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/753,705

Applicant(s)

AHMED ET AL.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-28,35-41 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28,35-41,45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 21-28,35-41,45-47 are pending. Claims 21,35,45 have been amended.

This is a Final Action.

2. This application claimed priority of 9/20/1999.

Response to Arguments

3. Applicant's arguments, see pages 8-10, filed 10/19/06, with respect to the rejection(s) of claim(s) 21-28,35-41,45-47 under Klein-Kelly have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Farber.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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A. Claims 21-28,35-41,45-47 rejected on the ground of nonstatutory double patenting over claims 1-33 of U. S. Patent No. 6,704,772 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('772) 1. In an e-mail messaging system that provides clients of a host system with electronic messaging services, a method for providing access to an e-mail message, to a plurality of intended recipients, and in a way that reduces potential storage and processing requirements otherwise associated with duplicating the e-mail messages for each intended recipient, the method comprising the steps of:	(Application) 1. In a messaging system that provides clients with electronic messaging services, a method for organizing one or more replies to an electronic message, comprising the steps of:
creating a distribution list that includes a plurality of intended recipients of an e-mail message;	assigning a unique identifier to the electronic message; using the unique identifier to associate the one or more replies with the electronic message;
storing a single copy of the e-mail message at a host system to be <u>shared by the plurality of intended recipients</u> , regardless of whether the e-mail message has one or more associated attachments, and rather than storing a duplicate copy of the e-mail message for each of the plurality of intended recipients the e-mail message including one or more rules that define how the e-mail message can be used by the intended recipients; and	Storing a single copy of the electronic mess at a host system to be shared by a plurality of intended recipients; and
without transmitting copies of the email message to the intended recipients, using the distribution list to send a notification message	Storing single copy of the one or more replies at the host system to be shared by the plurality of intended recipients such that the

to each of the intended recipients that notifies each of the intended recipients of the e-mail message and that includes a link that can be used by the intended recipients to access the single copy of the e-mail message through the host system, as permitted by the one or more rules, and so as to <u>enable the single copy</u> of the e-mail message to be shared by each notified recipient, as permitted by the one or more rules.	one or more replies and the associated electronics message may be accessed by each of the plurality of intended recipients.
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It was well-known in the art that a message or file was identified by message ID or file name.

B. Claims 21-28,35-41,45-47 rejected on the ground of nonstatutory double patenting over claims 1-33 of U. S. Patent No. 6,704,772 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(‘587) 1. A method for <u>sharing a data object amongst multiple clients</u> (i.e.: shared by the plurality of intended recipients) and distributing changes made to the data object among the clients comprising the steps of:	(Application) 1. In a messaging system that provides clients with electronic messaging services, a method for organizing one or more replies to an electronic message, comprising the steps of:
publishing the data object to at least one subscription client from a publishing client so that <u>a data object copy</u> (i.e.: a single copy) resides at each subscription client;	assigning a unique identifier to the electronic message; using the unique identifier to associate the one or more replies with the electronic message;
receiving, at the publishing client, changes to the data object from one of the subscription clients over a store and forward transport; and	Storing a single copy of the electronic mess at a host system to be shared by a plurality of intended recipients; and

distributing the changes from the publishing client to the clients not aware of the changes so that the data object and data object copies may reflect the changes.	Storing single copy of the one or more replies at the host system to be shared by the plurality of intended recipients such that the one or more replies and the associated electronics message may be accessed by each of the plurality of intended recipients.
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It was well-known in the art that a message or file was identified by message ID or file name.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claim Rejections - 35 USC § 112

5. Claims 21-28,35-41,45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i.e.: (claim 21) ...**may be** accessed by each of the plurality of intended recipients

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-28,35-41,45-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Farber et al [Farber 5,978,791].

6. As per claim 21, Farber discloses In a messaging system that provides clients with electronic messaging services, a method for organizing one or more replies to an electronic message, comprising the steps of:

assigning a unique identifier to the electronic message [Farber, file name, col 5 lines 43];

using the unique identifier to associate the one or more replies with the electronic message [Farber, response with True File ID, col 16 lines 15-25];

Storing a single copy of the electronic message at a host system to be shared by a plurality of intended recipients [Farber, the system stores a single copy or one copy, col 14 lines 48-50; shared file server, shared database, col 8 lines 1-10]; and

Storing single copy of the one or more replies at the host system to be shared by the plurality of intended recipients [Farber, the system stores a single copy or one copy, col 14 lines 48-50] such that the one or more replies and the associated electronics message may be accessed by each of the plurality of intended recipients [Farber, shared file server, shared database, col 8 lines 1-10].

7. As per claim 22, Farber discloses assigning a reply identifier to a first reply created by a recipient of the electronic message;

using the reply identifier to associate, with the first reply, each of one or more subsequent replies created in response to the first reply [Farber, subsequent access, col 42 lines 58-67].

8. As per claim 23, Farber discloses the step of separately presenting the electronic message and the one or more replies to a recipient [Farber, separate processor, col 2 lines 35; separate volume, col 28 line 58].

9. As per claim 24, Farber discloses the step of separately presenting the electronic message, the first reply and the one or more subsequent replies to a recipient [Farber, subsequent access, col 42 lines 58-67].

10. As per claim 25, Farber discloses the step of separately presenting the electronic message, the first reply, and the one or more subsequent replies comprises the step of presenting to the recipient a tree arrangement wherein the electronic message is a trunk, the first reply is a first-level branch depending from the trunk, and the one or more subsequent replies are second-level branches depending from the first-level branch [Farber, separate processor, col 2 lines 35; separate volume, col 28 line 58].

11. As per claim 26, Farber discloses the method includes steps for distributing the electronic message to clients of a host system, comprising the steps of:

creating one or more distribution lists including each client of the host system who is a recipient of the electronic message [Farber, create a data item or list field name, col 18 lines 30-48];

storing at least one copy of the electronic message at the host system [Farber, the system stores a single copy or one copy, col 14 lines 48-50; shared file server, shared database, col 8 lines 1-10]; and

using the one or more distribution lists to notify each client of the host system who is a recipient of the electronic message, such that the at least one copy of the electronic message is made available to each notified client [Farber, notify the user, col 17 lines 28-32].

12. As per claim 27, Farber discloses the method includes steps for distributing replies to the electronic message, comprising the steps of:

assigning a unique list identifier to the distribution list [Farber, table name, col 1 line 48];

storing at least one copy of a reply created in response to the electronic message [Farber, the system stores a single copy or one copy, col 14 lines 48-50; shared file server, shared database, col 8 lines 1-10]; and

notifying each client who is a recipient of the reply using the unique list identifier, such that the at least one copy of the reply is made available to each client who is a recipient of the reply [Farber, notify the user, col 17 lines 28-32].

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13. As per claim 28, Farber discloses assigning a reply identifier to a first reply; and using the reply identifier to associate, with the first reply, each of one or more subsequent replies created in response to the first reply [Farber, subsequent access, col 42 lines 58-67].

14. Claims 35-41,45-47 contain the similar limitations set forth in claims 21-28.

Therefore claims 35-41,45-47 are rejected for the same rationale set forth in claims 21-28.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

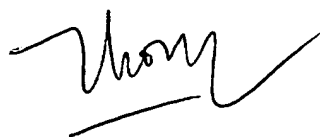
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
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Art Unit 2142



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